

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Dennis G. A. Nelson et al.

APPLICATION NO.: Priority of Provisional Application
60/124,258 filed March 12, 1999

Examiner: Unassigned

FILING DATE: Herewith

Group Art Unit: Unassigned

TITLE: COMPOSITIONS COMPRISING A POTASSIUM
SALT ACTIVE INGREDIENT, INCLUDING ORAL
COMPOSITIONS FOR REDUCING DENTAL NERVE
AND DENTIN SENSITIVITY COMPRISING A
NON-MENTHOL FLAVORING

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

**PETITION UNDER 37 CFR §1.47(a)
TO ACCEPT FILING BY ONE OF JOINT INVENTORS**

Dennis Nelson, a co-inventor of the above identified provisional application and of the attached application, through the undersigned attorney, hereby petitions the Commissioner to accept the application on behalf of himself and co-inventor, Andrew Gallopo ("Dr. Gallopo"), who specifically refuses to join in the application or to sign any documents including the Declaration for the attached application which was sent to him for execution. Dr. Gallopo's current address is 4B-A Foxwood Drive, Morris Plains, New Jersey, 07950.

Enclosed herewith are declarations by Kristina L. Konstas, the attorney who filed the original provisional application, and by the undersigned attorney, Israel Nissenbaum; with whom Dr. Gallopo had correspondence and to whom he vehemently expressed his refusal to sign any documents or to join in the present application. The declarations set forth a correspondence chronology with proof of the pertinent facts, by attestation and by supporting documentary exhibits.

In narrative summary, Dr. Gallopo was hired by Pfizer Inc ("Pfizer"), assignee of the provisional and present applications (by recorded assignment and contractual agreement), as an outside consultant, to assist in Pfizer in development of oral care products, during the time period January 1, 1997 to June 30, 1997 (the term of the agreement was not extended at the expiry thereof). By express agreement (letter consulting Agreement dated December 18, 1996-executed by Dr. Gallopo on January 4, 1997- Exhibit A herein), Dr. Gallopo agreed that Pfizer was to be the exclusive owner of inventions arising from work under the agreement and that he would, "...execute such documents and take such other action, at the Company's expense, as may be necessary or appropriate to establish such ownership and to assist the Company in obtaining patents thereon in the United States and/or foreign countries...". The provisional application and present application encompass work done under the agreement in conjunction with Dennis Nelson, a Pfizer employee.

Dr. Gallopo was no longer a consultant to Pfizer when the provisional application was prepared and filed on March 12, 1999. He reviewed the application prior to filing and provided some comments, for which he was paid in the amount of \$500 (the term in the Agreement of "at the Company's expense" was read by Dr. Gallopo as indicating compensation for his reviewing of the application) in order to obtain Dr. Gallopo's co-operation even though Pfizer had no obligation for any such payment under the

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agreement. From the filing date of the provisional application until about the end of June, 1999, there was a series of correspondence between Kristina L. Konstas and Dr. Gallopo [Exhibits B-L] wherein Dr. Gallopo was asked to execute an assignment for the application for an agreed to compensation of \$125 (again offered to ensure cooperation). Dr. Gallopo suggested changes to the assignment, which were effected, but took umbrage at Pfizer's assertion that this amount included payment for signing documents for the non-provisional application and documents for foreign filings (if any) for which he had not agreed, stating, in writing that Pfizer was not to contact him again. When Ms. Konstas nevertheless contacted him by way of clarification and apology, Dr. Gallopo insisted that the agreed to \$125 payment was just for his signing of the assignment of the provisional application and not for any other other documents including the non-provisional US and foreign filings, at which point he asked for \$3225 for signing the original assignment, with other documents to be extra. Dr. Gallopo, in the correspondence nevertheless acknowledged ownership by Pfizer of the invention and application and asked that Pfizer file without his signature on the documents, without contacting him further.

Israel Nissenbaum, the undersigned attorney, assigned to effect the non-provisional and foreign filings, due by March 12, 2000, though advised of Dr. Gallopo's effective refusal to sign any documents for Pfizer, nevertheless sent both the application and declaration to Dr. Gallopo with an apologetic letter indicating that the US Patent and Trademark Office requires all the inventor's signatures on declarations and that Pfizer could not sign for him or file without his signature but that his signature would not be construed as an assignment.

The application and declaration were returned unsigned (the original, with envelope, is attached as Exhibit II), but with the pages marked with vehement statements that he not be contacted again (re-iterated), with the signature area of the declaration marked "VOID", that no more documents were to be sent to him, and that it was a "3rd warning".

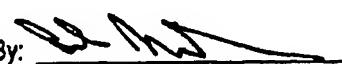
It is very clear that Dr. Gallopo will not sign or join in the present application and that actions in full compliance with the provisions of 37 CFR §1.47 have been taken in trying to obtain his signature. Grant of the petition to accept the present application, without Dr. Gallopo's signature, on behalf of co-inventor Dennis Nelson, is appropriate and is so requested.

It is further petitioned that with grant of this petition and acceptance of the application, that the USPTO, in sending notice of the filing to Dr. Gallopo, clearly indicate that such notification is only from the USPTO, in accordance with its procedures, and is not attributable to Pfizer.

Please charge the fee for the present petition to Deposit Account No. 16-1445.

Respectfully submitted,
Dennis G. A. Nelson

Date: February 14, 2000

By: 
Israel Nissenbaum
Attorney for Applicant
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